

## **REMARKS**

The Office Action mailed October 27, 2008 was received and carefully reviewed. Applicants filed a Request for Continued Examination (RCE) concurrently with this Amendment. Claims 1-78 were pending prior to the Office Action mailed October 27, 2008.

In the above amendments, Applicants canceled claims 2, 4-9, 13, 17-19, 22, 23, and 26-78. Applicants amended claims 1, 3, 10-12, 14-16, 20, 21, 24, and 25. Applicants added new claims 79-101 in this Amendment. The amended and new claims highlight features of the present invention and provide additional context to the claims. Support for the above amendments may be found in the Specification at least in paragraphs [0017, 0026-0028] and in Figures 1-3 and throughout the Specification. Applicants respectfully submit that no new matter was introduced by these amendments.

As now recited, claims 1, 3, 10-12, 14-16, 20, 21, 24, 25, and 79-101 are pending and are believed to be in condition for allowance. Applicants respectfully request reconsideration of this application in light of the above amendments and the following remarks.

### **A. Claim Rejections under 35 U.S.C. § 101**

Claims 26-28, claims 54-60, and claims 62-78 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject as indicated beginning on page 2 of the October 27, 2008, Office Action. In the above amendments, Applicants canceled claims 26-28, claims 54-60, and claims 62-78. As such, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 101 is moot and request that the rejection be withdrawn.

## B. Claim Rejections under 35 U.S.C. § 103

Claims 1, 2, 4-7, 9, 10, 13, 16, 26, 29, 30, 32-35, 37, 38, 41, 44, 54, 55, 57-60, 62, 63, 66, 67, and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishio UK Patent Application GB 2,302,635 (“the Nishio reference”) in view of Pinera et al. U.S. Patent Number 7,231,650 (“the Pinera patent”). In the above amendments, Applicants canceled claims 2, 4-7, 9, 13, 26, 29, 30, 32-35, 37, 38, 41, 44, 54, 55, 57-60, 62, 63, 66, 67, and 69. As such, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) is moot and request that the rejection be withdrawn. Applicants amended claims 1, 10, and 16 as indicated above. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of this rejection.

The present invention is generally directed to a system, method, and device for selected content distribution, such as advertising content distribution. For example, amended independent claim 1 recites a computer-implemented method for distributing content to a content consumption device having an audio output channel and a video output channel. The method of claim 1 includes detecting a fast forward action performed by the content consumption device during rendering of preferred content that makes available the audio output channel of the content consumption device by the performing of the fast forward action. The method recited in amended independent claim 1 also includes selecting audio content to be played on the content consumption device on the available audio output channel based on an automated algorithm that selects audio content to be played from a repository of audio content. Further, claim 1 recites playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action.

In contrast, the Nishio reference appears to disclose a video server used for a video-on-demand system that is based on a video tape storage system. The system

described in the Nishio reference appears to employ a video server that identifies how long a specific reproduction control command will take to be served and identifies content that is roughly of that same duration as the non-transmission idle time. See page 3, paragraph 2 of the Nishio reference. The video server then plays that “same duration content” while processing the control command during the idle time. See page 5, first paragraph. When a user selects a specific reproduction control command, such as Pause, Fast-Forward, or Fast-Rewind, the subscriber terminal sends the control command to the video server. See page 7, starting in the last paragraph. The video server then uses a switching means for switching from the special video program to the reproduced same duration content. See page 8, starting in line 4. The switching means produce a selection signal to switch between the original content “special video program” and the reproduced timed content to coincide with the length of the specific reproduction control command. See page 8 of the Nishio reference. The switching means selects between alternative video programming from the transmitted original content (a.k.a. “special video program”) to the timed “reproduced special video program” (a.k.a. “timed content”).

Additionally, the Pinera patent discloses a method of expanding business potential of local live event performances by presenting the performances on television or radio and including “infomercial” material in the broadcasts. The Pinera patent discusses expanding marketing venues for locally performed events by simulcasting the live local event. See col. 2, lines 1-10 of the Pinera patent. During the simulcast, advertisements are superposed on the program to solicit sales of digital recordings of the event. See col. 2, lines 11-15. That is, the Pinera patent discusses broadcasting a live entertainment event and providing advertisements for viewing by the telecast audience. See col. 2, lines 1-25.

1. The Combination of the Nishio Reference and the Pinera Patent Does Not Disclose or Suggest Playing the Selected Audio Content on the Content Consumption Device on the Available Audio Output Channel Simultaneously with the Preferred Content During the Performing of the Fast Forward Action.

The Nishio reference focuses on a system and method of supplying alternative content to a user when the original transmitted content is not available, such as during the time when a specific reproduction control command is serviced by the system. In the Nishio reference, a plurality of video servers use a video switch to select one type of content for delivery. When the “reproduced special video program” (that is, the “timed content”) is selected for delivery, there is no transmission of the “special video program” (that is, the “original content”). See page 11, starting in the third paragraph.

There is no disclosure or suggestion in the Nishio reference of playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action as recited by amended independent claim 1 of the present application. The Nishio reference may employ multiple video servers to store video content, but the system of the Nishio reference employs a single channel with which to deliver content to a subscriber. The system of the Nishio reference switches inputs to the delivery channel to deliver either the special video program or the timed “reproduced special video program.” See page 12, third paragraph of the Nishio reference as well as page 17, third paragraph through page 20, paragraph 3. A new connection path is formed between the video storage units and the video signal transmission path in the Nishio reference. There is no disclosure or suggestion of playing the selected audio content simultaneously with the preferred content, that is the “special video program,” on the available audio output channel during the performing of the fast forward action on the content consumption device, as recited by claim 1 of the present application.

As the Examiner concedes at the top of page 5 of the Office Action mailed on October 27, 2008, “Nishio does not explicitly teach of a method of displaying the

selected content and preferred content simultaneously.” The Examiner then relies upon the Pinera patent to remedy the deficiencies of the Nishio reference.

2. The Pinera Patent Does Not Disclose or Suggest Playing the Selected Audio Content on the Content Consumption Device on the Available Audio Output Channel Simultaneously with the Preferred Content During the Performing of the Fast Forward Action.

Amended independent claim 1 of the present application recites, “... playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action.” As outlined above, the Nishio reference switches between separate video content based upon a reproduction control command. There is no simultaneous playing of the selected targeted content with the rendered preferred content on the available channel of the device as required by amended independent claim 1 of the present application. In the Nishio reference, switching commands are sent from subscriber terminals through interface units to switch the video program. See page 18, first paragraph of the Nishio reference. New connection paths are formed based upon the received switching commands. See page 19, first paragraph. These separate connection paths preclude simultaneous playing of the selected targeted content along with the rendering of the preferred content on the available channel of the device as recited in claim 1 of the present application.

In the Pinera patent, a live performance is simulcast on television or other broadcast media as a means of financially expanding the business potential of local live events. See col. 1, lines 53-54 of the Pinera patent. Live performers play to an audience. Behind the performers is a large screen showing video footage of the live performance. The audio and video may be broadcast for viewing by remote audiences as well. See col. 2, line 58 to col. 3, line 10.

In the Pinera patent, infomercial advertising supplementation may be displayed on the large screen for viewing by the live audience. During the broadcast, infomercial sales pitches are superposed with the program. See col. 3, lines 11-25. The Examiner asserts that “Pinera teaches … playing the selected content on the device on the available channel simultaneously with the preferred content” and equates the playing of the content of the local live performance and with superposed simultaneous infomercial material as meeting the recited feature of amended independent claim 1.

However, the broadcast of video images with integrated text, as in the Pinera patent, is not the same as playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action as recited in amended independent claim 1 of the present application. In the Pinera patent, there is no disclosure or suggestion of an audio output channel upon which audio content is played simultaneously with the preferred content. Further, there is no disclosure or suggestion of playing audio content on the content consumption device on the audio channel simultaneously with preferred content during the performing of the fast forward action as recited in amended independent claim 1. The Pinera patent merely discloses that advertisements are present on signage and elsewhere (that is, on projection screens, behind or flanking the stage) and that infomercial text may be displayed during the broadcast of the live event to solicit sales. See Figure 2 and the accompanying text in col. 2, lines 62-67 and col. 3, lines 20-26.

While the Pinera patent appears to describe “infomercial sales pitches and marketing advertisements 1 superposed on or interleaved with the program to generate interest by the television audiences in the recorded digital discs and tapes,” there is no disclosure or suggestion of audio content selected from a repository that is played on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action as recited in

amended independent claim 1. Instead, the Pinera patent appears to disclose a live event that is broadcast with audio and video and possibly superposed infomercial sales pitches and marketing advertisements. There is no mention in the Pinera patent of audio content selected from a repository played on an available audio output channel simultaneously with preferred content during a fast forward operation.

In the present application, audio content is selected from the advertising repository to play on the available audio output channel of the content consumption device based upon an automated algorithm. As the user selects a fast forward action with the user interface, audio channels can become available for playing the selected audio content. The monitoring component then provides the selected audio content on the available audio output channel. See paragraph [0026] of the present specification.

As indicated above, both the Nishio reference and the Pinera patent fail to disclose or suggest all the elements recited in amended independent claim 1 of the present application. Applicants respectfully submit that the combination of the Nishio reference and the Pinera patent fails to render amended independent claim 1 obvious under 35 U.S.C. § 103(a) and that amended independent claim 1 is in proper condition for allowance. Applicants respectfully request reconsideration of amended independent claim 1 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

3. The Dependent Claims and the Related Claims Are Patentable over the Combination of the Nishio Reference and the Pinera Patent

Claims 10 and 16 of the present application depend upon independent claim 1 and thereby include all the limitations of claim 1 while reciting additional features of a method of the present invention. Applicants respectfully traverse the rejection of claims 10 and 16 for similar reasons as outlined above with regard to the rejection of claim 1 under 35 U.S.C. § 103(a). As discussed above, the cited combination of references fails to disclose all the elements and limitations recited in amended independent claim 1 of the

present application. Therefore, the applied combination of references also fails to disclose all the features and limitations of dependent claims 10 and 16 as well. Accordingly, Applicants respectfully submit that claims 10 and 16 are allowable at least by virtue of their dependency upon claim 1 as outlined above. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 10 and 16 under 35 U.S.C. § 103(a).

4. The New Claims Added in this Amendment are also Patentable over the Combination of the Nishio Reference and the Pinera Patent

Applicants also added new independent claims 79 and 91 to recite related methods of the present invention similar to amended independent claim 1. Claim 1 and claims 79 and 91 are related claims that recite methods for distributing content to a content consumption device and playing the selected content simultaneously with preferred content during performance of a user action in accordance with the present invention.

As outlined above with regard to amended claim 1, the combination of the Nishio reference and the Pinera patent fails to disclose or suggest all the elements and limitations recited in independent claim 1 of the present application. Similarly, the combination of the Nishio reference and the Pinera patent also fails to disclose all the related elements and limitations of independent claims 79 and 91 as well. Therefore, Applicants respectfully submit that claims 79 and 91 are allowable over the cited combination of references for at least the reasons outlined above with regard to claim 1. Applicants respectfully request that the rejection of claim 29 under 35 U.S.C. § 102 be withdrawn.

Claims 80-90 and claims 92-101 of the present application depend upon claim 79 and 91, respectively, and thereby include all the limitations of independent claims 79 and 91, respectively, while reciting additional features of a method of the present invention. Applicants respectfully submit that claims 80-90 and claims 92-101 are allowable over the combination of the Nishio reference and the Pinera patent for similar reasons outlined

above with regard to claim 1. As discussed above, the cited combination of references fails to disclose all the elements and limitations recited in independent claims 1, 79, and 91 of the present application. Therefore, the applied combination of references fails to disclose all the features and limitations of dependent claims 80-90 and claims 92-101 as well. Accordingly, Applicants respectfully submit that claims 80-90 and claims 92-101 are allowable at least by virtue of their dependency upon claims 79 and 91 as outlined above.

#### **C. Claim Rejections under 35 U.S.C. § 103 that Include The Bacso Application**

Claims 3, 11, 12, 17-21, 24, 31, 39, 40, 45-49, 52, 56, 64, 65, 70-74, and 77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishio UK Patent Application GB 2,302,635 (“the Nishio reference”) as applied to claims 1, 2, 29, 30, 54, and 55 above, in view of Bacso et al. U.S. Patent Application Publication Number 2002/0124182 (“the Bacso application”). In the above amendments, Applicants canceled claims 17-19 and claims 31, 39, 40, 45-49, 52, 56, 64, 65, 70-74, and 77. As such, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) is moot and request that the rejection be withdrawn.

In the above amendments, Applicants amended claims 3, 11, 12, 20, 21, and 24 to further highlight the features of a method in accordance with the present invention. In view of the amendments above and the comments below, Applicants respectfully request reconsideration of claims 3, 11, 12, 20, 21, and 24 and the withdrawal of the rejection of these claims under 35 U.S.C. § 103(a).

##### **1. The Combination of the Nishio reference and the Pinera patent and the Bacso Application Fails to Disclose All Elements of Dependent Claims 3, 11, 12, 20, 21, and 24 and Fails to Render These Dependent Claims Unpatentable.**

Dependent claims 3, 11, 12, 20, 21, and 24 are dependent upon amended independent claim 1 and thereby include all the limitations of independent claim 1, while

reciting additional features of the present invention. As noted above, the amended independent claims include limitations not disclosed by the combination of the Nishio reference and the Pinera patent. Further, the Bacso application fails to remedy the deficiencies of the Nishio reference and the Pinera patent.

Applicants respectfully submit that these dependent claims are allowable at least for the same reasons as base claim 1. The Bacso application fails to disclose or suggest playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action. The Bacso application discusses a method and system for targeted content delivery in a communications network where users may control the content customized for them (see paragraphs 0032-0036]. The Bacso application appears to provide a feedback mechanism where the user may teach the distribution network the type of substitute content that the user prefers (see paragraphs [0075-0078]), however the Bacso application fails to disclose or suggest playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action.

As outlined above with regard to amended claim 1, the Bacso application fails to cure the deficiencies of the Nishio reference, and the combination fails to disclose or suggest all the elements and limitations recited in independent claim 1 of the present application. Accordingly, Applicants respectfully submit that the combination of references also fails to disclose or suggest all the related elements and limitations of dependent claims 3, 11, 12, 20, 21, and 24 as well. Therefore, Applicants respectfully submit that claims 3, 11, 12, 20, 21, and 24 are allowable over the cited combination of references for at least the reasons outlined above with regard to claim 1. Accordingly, Applicants respectfully request the reconsideration of claims 3, 11, 12, 20, 21, and 24 and withdrawal of the rejections under 35 U.S.C. § 103.

## D. Claim Rejections under 35 U.S.C. § 103 that Include The Tsuchida Application

Claims 8, 14, 15, 22, 23, 25, 27, 28, 36, 42, 43, 50, 51, 53, 61, 68, 76, 76, and 78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishio UK Patent Application GB 2,302,635 (“the Nishio reference”) as applied to claims 1, 2, 29, 30, 54, and 55 above, in view of Tsuchida et al. U.S. Patent Application Publication Number 2002/0194592 (“the Tsuchida application”). In the above amendments, Applicants canceled claims 8, 22, 23, and claims 27, 28, 36, 42, 43, 50, 51, 53, 61, 68, 76, 76, and 78. As such, Applicants respectfully submit that the rejection of these claims under 35 U.S.C. § 103(a) is moot and request that the rejection be withdrawn.

In the above amendments, Applicants amended claims 14, 15, and 25 to further highlight the features of a method in accordance with the present invention. In view of the amendments above and the comments below, Applicants respectfully request reconsideration of claims 14, 15, and 25 and the withdrawal of the rejection of these claims under 35 U.S.C. § 103(a).

### 1. The Combination of the Nishio reference and the Pinera patent and the Tsuchida Application Fails to Disclose All Elements of Dependent Claims 14, 15, and 25 and Fails to Render These Dependent Claims Unpatentable.

Dependent claims 14, 15, and 25 are dependent upon amended independent claim 1 and thereby include all the limitations of independent claim 1, while reciting additional features of the present invention. As noted above, the amended independent claims include limitations not disclosed by the combination of the Nishio reference and the Pinera patent. Further, the Tsuchida application fails to remedy the deficiencies of the Nishio reference and the Pinera patent.

Applicants respectfully submit that these dependent claims are allowable at least for the same reasons as base claim 1. The Tsuchida application fails to disclose or

suggest playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action. The Tsuchida application appears to discuss a system and apparatus for displaying substitute content in response to a break in the broadcast content. See paragraph [0027] of the Tsuchida application. The Tsuchida application appears to disclose a number of instances where substitute programming may be viewed in place of live programming (see paragraphs [0028-0033]), the Tsuchida application fails to disclose or suggest playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action.

As outlined above with regard to amended claim 1, the Tsuchida application fails to cure the deficiencies of the combination of the Nishio reference and the Pinera patent, and the combination fails to disclose or suggest all the elements and limitations recited in independent claim 1 of the present application. Accordingly, Applicants respectfully submit that the combination of references also fails to disclose or suggest all the related elements and limitations of dependent claims 14, 15, and 25 as well. Therefore, Applicants respectfully submit that claims 14, 15, and 25 are allowable over the cited combination of references for at least the reasons outlined above with regard to claim 1. Accordingly, Applicants respectfully request the reconsideration of claims 14, 15, and 25 and withdrawal of the rejections under 35 U.S.C. § 103.

## **E. Conclusion**

In view of the above amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application and the timely allowance of the pending claims. Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be

required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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